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09/283,120 03/31/99 WAGONER

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EXAMINER

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CALVE, J  
ART UNIT PAPER NUMBER

2164  
DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/283,120

Applicant(s)

WAGONER, Kevin J. et al

Examiner

Jim Calve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Jul 16, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above, claim(s) 1-37 and 41-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 20) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of the invention of Group VI (claims 38-40) in Paper No. 8 is acknowledged. The traversal appears to be on the ground(s) that newly-presented claims 47-52 link Group VI to the non-elected claims of Groups I-V and VII-XI. This is not found persuasive because the inventions recited in newly-presented claims 47-52 are not considered to be linking claims within the meaning of MPEP 809.03 (e.g., they are not genus claims linking species claims or any of the other common types recited in MPEP 809.03 (A)-(D)). Further, claims 47-52 are deemed to be patentably distinct from the invention recited in Group VI (claims 38-40) for the following reasons:

Inventions VI and claim 47 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention VI has separate utility such as providing an online product auction system including a microprocessor, storage media, first and second bid data and bid processing module that calculates a high bid for the first product. Further, claim 47 has separate utility such as providing an online product auction system with microprocessor, storage media, product information receive module to receive first product data including one or more seller parameters, a seller proxy module to modify the one or more seller parameters based on one or more auction parameters, a seller notification module to receive one or more auction events and notify the seller upon occurrence thereof, a bidder notification module to receive one or more bid events and notify the bidder upon occurrence thereof, a potential bidder notification module to

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receive one or more auction search criteria from a potential bidder and identify one or more product auctions that satisfy such auction search criteria, a bid processing module that determines a winning bidder for a first auction, an escrow module informing an escrow provider of a result of the first auction, and a sale consummation module receiving confirmation of an exchange of the first product and winning bid to remove the first auction from the auction center. See MPEP § 806.05(d).

Invention VI and claim 48 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention VI has separate utility such as providing an online product auction system including a microprocessor, storage media, first and second bid data and bid processing module that calculates a high bid for the first product. Further, claim 48 has separate utility such as providing an online product auction system with microprocessor, storage media, product information receive module to receive first product data including one or more seller parameters, a seller proxy module to modify the one or more seller parameters based on one or more auction parameters, a bid processing module that determines a winning bidder for a first auction, an escrow module informing an escrow provider of a result of the first auction, and a sale consummation module receiving confirmation of an exchange of the first product and winning bid to remove the first auction from the auction center. See MPEP § 806.05(d).

Invention VI and claim 49 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention VI has separate utility such as providing an online

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product auction system including a microprocessor, storage media, first and second bid data and bid processing module that calculates a high bid for the first product. Further, claim 49 has separate utility such as providing an online product auction system with microprocessor, storage media, product information receive module to receive first product data including one or more seller parameters, a seller proxy module to modify the one or more seller parameters based on one or more auction parameters, a bid processing module that determines a winning bidder for a first auction. See MPEP § 806.05(d).

Claim 50 and Invention VI are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process (MPEP § 806.05(e)). In this case the process of claim 50 can be practiced by another materially different apparatus that provides one or more auction parameters, receives one or more seller parameters, and modifies one or more seller parameters based on the one or more auction parameters, sets a current high bid as a sum of a proxy increment and the smaller of a second bid and fourth bid when a second condition is met, receives one or more auction events for a first product auction from a seller, notifies the seller upon occurrence of one or more auction events, receives one or more bid events from a bidder and notifies the bidder upon occurrence of such bid events, identify product auctions that satisfy one or more auction search criteria, informs an escrow provider of a winning bid to consummate an exchange, receives confirmation from the escrow provider, and removes the first product from the auction center. Additionally, the apparatus as claimed can be used to practice another and

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materially different process by calculating a new high bid for a first product with first and second bid data in which a second bid is at least as large as a first bid and a fourth bid is at least as large as a third bid.

Claim 51 and Invention VI are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process (MPEP § 806.05(e)). In this case the process of claim 51 can be practiced by another materially different apparatus that provides one or more auction parameters, receives one or more seller parameters, and modifies one or more seller parameters based on the one or more auction parameters, commences a first product auction with one or more seller and auction parameters, sets a current high bid to be larger than the smaller of a second and fourth bid when a first condition is met, sets a current high bid to be a sum of a proxy increment and the smaller of a second bid and fourth bid when a second condition is met, informs an escrow provider of a winning bid to consummate an exchange, receives confirmation from the escrow provider, and removes the first product from the auction center. Additionally, the apparatus as claimed can be used to practice another and materially different process by calculating a new high bid for a first product with first and second bid data in which a second bid is at least as large as a first bid and a fourth bid is at least as large as a third bid.

Claim 52 and Invention VI are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to

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practice another and materially different process (MPEP § 806.05(e)). In this case the process of claim 52 can be practiced by another materially different apparatus that provides one or more auction parameters, receives one or more seller parameters, and modifies one or more seller parameters based on the one or more auction parameters, commences a first product auction with one or more seller and auction parameters, sets a current high bid to be larger than the smaller of a second and fourth bid when a first condition is met, and sets a current high bid to be a sum of a proxy increment and the smaller of a second bid and fourth bid when a second condition is met. Additionally, the apparatus as claimed can be used to practice another and materially different process by calculating a new high bid for a first product with first and second bid data in which a second bid is at least as large as a first bid and a fourth bid is at least as large as a third bid.

The requirement is still deemed proper and is therefore made FINAL.

2. Accordingly, claims 1-37 and 41-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

### *Specification*

3. The disclosure is objected to because of the following informalities:

a. The reference on page 1, lines 2-6, page 16, lines 24-27, and page 22, lines 11-15 to co-pending U.S. Patent application serial number 09/231,049, filed January 14, 1999, should be amended to reflect the correct serial number: 09/231,409, filed January 14, 1999, and now U.S. patent 6,282,517.

Appropriate correction is required.

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*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Fisher et al, U.S. patent 5,835,896.

Fisher et al disclose an online product auction system, including microprocessor and storage media (e.g., Figure 1; column 7, line 24 et seq), first and second bid data with first, second, third, and fourth bids, the second and fourth bids (e.g., proxy bids) (Figure 7) being at least as large as the first and third bids, respectively (e.g., column 9, line 17 et seq), bid processing module (e.g., column 10, line 5 et seq; column 11, line 20 et seq), current and new high bid (e.g., Figures 6-10; column 9, line 1 et seq; column 10, line 40 et seq; column 11, line 65 et seq).

Fisher et al also disclose first and second calculation modes to calculate a high bid in first and second respective states (e.g., "Dutch Auction" and "Progressive Auction" formats) (e.g., column 10, line 29 et seq).

6. Claims 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Barzilai et al, U.S. patent 6,012,045.

Barzilai et al disclose an online product auction system (e.g., column 1, line 52 et seq), including microprocessor and storage media (e.g., Figure 1), first and second bid data with first



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through fourth bids, wherein the second and fourth bids are at least as large as the first and third bids, respectively (e.g., Figures 6A-10; column 2, line 1 et seq; column 6, line 1 et seq; column 13, line 25 et seq; column 14, line 10 et seq; column 15, line 60 et seq), bid processing module (e.g., column 2, line 41 et seq; column 13, line 26 et seq), current and new high bid calculation (e.g., Figure 7; column 2, line 41 et seq; column 17, line 17 et seq; column 18, line 8 et seq).

Barzilai et al also disclose first and second calculation modes in first and second respective states (e.g., real play versus game play) (e.g., column 2, line 41 et seq; column 20, line 11 et seq).

7. Claims 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Mori et al, U.S. patent 6,044,363.

Mori et al disclose an online product auction system, including microprocessor and storage media (e.g., Figure 2), first and second bid data with first through fourth bids, wherein the second and fourth bids are at least as large as the first and third bids, respectively (e.g., column 2, line 28 et seq; column 6, line 19 et seq; column 7, line 5 et seq), bid processing module (e.g., column 10, line 24 et seq; column 11, line 5 et seq; column 14, line 3 et seq), current and new high bid calculation (e.g., column 11, line 5 et seq; column 12, line 32 et seq; column 14, line 3 et seq).

First and second calculation modes calculating a high bid when the product auction system is in a first and second state (e.g., determination of various states of competition; descending price method; concrete automatic auction method) (e.g., column 8, line 21 et seq; column 9, line 60 et seq; column 10, line 24 et seq; column 11, line 6 et seq; column 13, line 55 et seq).

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*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Luke et al, U.S. patent 6,131,087.
- b. Woolston, U.S. patent 5,845,265.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim Calve, whose telephone number is (703) 308-1884. The examiner can be reached on Monday through Friday from 6:45 am to 6:45 pm. If the examiner is unavailable, the examiner's supervisor, Vincent Millin, may be reached at 703-308-1065. The fax number of the organization is 703-308-9051/9052. Any inquiry of a general nature should be directed to the receptionist at 703-305-3900.

JPC  
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August 14, 2001

  
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